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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/618,766 | 07/18/2000 | Matthew W. Milne | K35A0625 | 8824 |

26332 7590 08/13/2003

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EXAMINER

NGUYEN, DUSTIN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2154

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/618,766

Applicant(s)

MILNE ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1 – 17 are presented for consideration.

Specification

2. Examiner requests Applicant to update status of any related applications as mentioned in the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3, 5, 7-11, 13-15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Welder [US Patent No 6,473,855].

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5. As per claim 1, Welder discloses the invention substantially as claimed including a method of delivering content from a content delivery server to a personal computer system that includes a computing subsystem and a disk drive, the method comprising:

selecting a network address for the content delivery server [col 9, lines 13-26];

selecting a server-contacting program [col 3, lines 43-58];

storing the network address and the server-contact program in the disk drive [col 4, lines 13-29];

installing firmware in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system [col 7, lines 45-55], wherein execution of the server-contact program includes using the network address for connecting the personal computer system to the content delivery server [col 9, lines 6-37]; and

configuring the content delivery server [col 2, lines 19-24; and col 9, lines 61-col 7, lines 2], the configuring comprising:

receiving user information from the personal computer system while the personal computer system is connected to the content delivery server [col 9, lines 53-61]; and

delivering content to the personal computer system in response to the user information [col 10, lines 12-15; and col 15, lines 47-56].

6. As per claim 2, Welder discloses a protected area; and the network address and the server-contacting program are stored in the protected area [col 7, lines 46-64].

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7. As per claim 3, Welder discloses the firmware resides in the disk controller circuit [col 6, lines 55-67].

8. As per claim 5, Welder discloses the personal computer system displays the content during a boot sequence [Abstract].

9. As per claim 7, Welder discloses the firmware delays initiating execution of the server-contacting program until the firmware determines that a selected number of monitored events exceeds a threshold [col 11, lines 20-46].

10. As per claim 8, Welder discloses the monitored events includes the number of boot-ups in the computing subsystem [col 2, lines 26-31].

11. As per claim 9, Welder discloses the content is selected from the group comprising: a content display program, a game, an entertainment program, a utility program, entertainment data, advertisement data, and music data [col 2, lines 51-55].

12. As per claim 10, it is apparatus claimed of claim 1, it is rejected for similar reasons as stated above in claim 1. Furthermore, Welder discloses a database including the user information associated with the disk drive in the personal computer system [col 5, lines 14-18].

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13. As per claim 11, Welder discloses the disk controller circuit automatically initiates execution of the server-contacting program when the disk drive is connected to the computing subsystem in the personal computer system [col 3, lines 55-58; and col 8, lines 52-58]

14. As per claims 13 and 14, they are apparatus claimed of claims 7 and 8, they are rejected for similar reasons as stated above in claims 7 and 8.

15. As per claim 15, it is apparatus claimed of claim 5, it is rejected for similar reason as stated above in claim 5.

16. As per claim 17, it is apparatus claimed of claim 9, it is rejected for similar reason as stated above in claim 9.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4, 6, 12, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welder [US Patent No 6,473,855], in view of Peterson et al. [US Patent No 6,594,682].

19. As per claim 4, Welder does not specifically disclose the firmware delays initiating execution of the server-contacting program until a predetermined period has lapsed. Peterson

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discloses the firmware delays initiating execution of the server-contacting program until a predetermined period has lapsed [Abstract]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Welder and Peterson because Peterson's teaching would allow the execution to be scheduled at necessary time, i.e. system idle time, to prevent reduce system performance.

20. As per claim 6, Welder does not specifically disclose the content is periodically changed according to a presentation schedule. Peterson discloses the content is periodically changed according to a presentation schedule [col 6, lines 38-52]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Welder and Peterson because Peterson's teaching of changing content would allow content to be updated more often to fit customer's need and provide more valuable information.

21. As per claim 12, it is apparatus claimed of claims 3 and 4, they are rejected for similar reasons as stated above in claims 3 and 4.

22. As per claim 16, it is apparatus claimed of claim 6, it is rejected for similar reason as stated above in claim 6.

23. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for

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response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703) 305-9678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen


ZARNI MAUNG
PRIMARY EXAMINER